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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,727	04/13/2000	Johan C. Talstra	PHN-17.410	7176

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

BOCCIO, VINCENT F

ART UNIT PAPER NUMBER

2616

DATE MAILED: 09/22/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/548,727

Applicant(s)

TALSTRA ET AL.

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,9 and 11 is/are allowed.
- 6) ☒ Claim(s) 7,8,10 and 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

**Response to Arguments**

1. Applicant's arguments with respect to the amended claims 7-8, new claims 12-21 {original/minor amendment 10}, have been considered but are moot in view of the new ground(s) of rejection.

**Status Id Objection**

It is noted that the status indicator for claim 8 is "original", but the claim is currently amended, please upon the next amendment change to the next proper indicator, such as either "previously presented", or "currently amended", it amending.

**Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7, 8, 12-16 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Linnartz et al. (PCT WO 99/11064).

Regarding claim 7, Linnartz discloses and meets the limitations associated with a method of exchanging copy protection information regarding an information carrying medium between a reading and application device (Figs. 5 and/or Fig. 6), the method comprising:

- wherein the copy protection information comprises a first characteristic (page top 11-12/13-14 bottom, "encoder pre-computers several Hash values over the MPEG content"), of the {MEG video} content of information transmitted from the reading device (52) **of the content** of the information transmitted from the

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reading device (transmit MPEG video, which Hash values were generated at the MPEG encoder); and

- a second characteristic of the content of information received by the application device after the transmission by the reading device (met by the decoder which computes hash values, page 12/14);
- after computing the characteristics being received by the reading device ("MPEG decoder returns the watermark W, plus the ... Hash value hi and signs the message");
- wherein the characteristics are verified comparing, wherein the result is used to stop the transmission, playback and/or recording of information in case of a mismatch of the characteristics ("The drives then compares decoded versions of si with ci"), wherein as understood upon a difference according to Fig. 5, would cause switch 54 to open and stop transmission, if the same, the transmission between the reading and application device, would continue, thereby effecting copy protection of the recorded material between a reading and application device.

Regarding claim 8, Linnartz discloses and meets the limitations associated with a method and corresponding apparatus for exchanging copy protected information having copy protection information on

- an information carrying medium (Fig. 5, "51"), from a reading device (Fig. 5, "52");
  - application device (w/decoder 57);
- o wherein the reading device comprises means for determining a first characteristic (unit 52, checks a first characteristic watermark, against corresponding characteristic or supplemental information such as a physical or control signals {another watermark}, with the watermark received thru path 56, Abstract, etc.....);
- o wherein the application device comprises means for determining the copy protected information comprises a first

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characteristic (video data with "watermarked content") of the content of information transmitted from the reading device; and

o wherein the characteristics are verified by comparison and wherein the result of the comparison is used to stop the transmission, playback and/or recording of information in case of a mismatch of the characteristics.

Regarding claims 12-13, Linnartz discloses and meets the limitations associated with a method and corresponding apparatus the method comprising:

- receiving information from a first source being a reading device (Fig. 5 reading from the disk "51 & 52");
- transmitting the information (from disk 51, thru switch and line/wire 54-55 to decoder 57);
- receiving a characteristic (abstract, watermark from disk), from a second source
- which is a playing and/or recording device (interpreted as one of therefore, met by the decoder 57 & display 58, and meets the limitation of a playing device), wherein the decoder 57, extract the watermark and from the signal of 51, sends back to 52, wherein the second source is different and met by the decoder 57 {decoder 57 -vs- disk 51}, being a source of a extracted watermark;
- determining (unit 53 of 52 of the source), whether the characteristic is derived from the contents of the information that was transmitted (met by wherein the watermark is checked against further supplemental information, such as "a physical mark on the carrier, against the extracted watermark from the decoder, thereby the determination is made by unit 52 with element 53, performing the comparison, also see page 11, line 16 to page 14 etc....., controlling the switch 54 of unit 52 or the reading device, based on check or comparison step.

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Regarding claims 14-16, Linnartz discloses and meets the limitations associated with a method and corresponding apparatus the method comprising:

- deriving a first characteristic (by an encoder, Pages 11-12 etc..... calculate or derive, a Hash value or hash values);
- from a first portion (MPEG content, transmitted);
- a first information signal (MPEG);
- by a first apparatus (such as Figs. 5-6, player "52", met by page 14, "MPEG encoder pre-computes several hash values over the MPEG content", "MPEG content plus the set of hash values are stored in the disc in encrypted form");
- transmitting, the first portion (the MPEG content or stream from which one of the hash values was derived, successive MPEG stream of content to the decoder 57, etc.... with respect to Fig. 6, pages 12-13, to the receiving unit met by the MPEG decoder 57 receiving side/unit for example);
- receiving the first portion transmitted, now referred to as "a second portion" (received first portion or the MPEG content from which the first characteristic was derived by the encoder);

wherein a second portion (is received, which is the first portion, transmitted, now referred to as a second portion of a second information signal, after the transmission of the first),

thereafter transmitting the first, now received called the second,

deriving a second characteristic (Hash value), from the received second portion (which is referred to as the first, when received referred to as the second therefore, {first = second});

transmitting the second derived characteristic back to the player (Fig. 5, such as 56), receiving and comparing by {53},

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wherein the transmitting from the player 52 to the decoder 57, is controlled by and depends upon the first and second derived characteristic signals controlling transmitting by switch 54, thereby copy protection of content is accomplished.

Regarding claims 17-18, Linnartz in Fig. 5, further discloses and meets the limitations as recited, a transmitter comprising:

- a first receiver (head) for receiving a first source (read head of unit 52);
- a transmitter (head to 53) for transmitting the information to;
- a second receiver (53, {which is an input for an electric signal}), for receiving a characteristic from a second source (57, thru 56 to 53),
- the second source (MPEG decoder 57), being separate from the transmitter and different than the first source; and
- processing means for determining whether the characteristic is derived from the transmitted portion of the information (either watermark and/or hash values, as analyzed and discussed with respect to the claims above), wherein depending upon a determination, terminating transmission at the switch 54, based on the comparison.

Claims 19-21 are analyzed and discussed with respect to the claims above.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (WO 99/11064) in view of Cox et al. (US 5,915,027).

Regarding claim 10 Linnartz in Fig. 5, discloses and meets the limitations as recited,

- an application device (57), for receiving information from
- a reading device for playback and/or recording comprising:
- an application reporting unit (57) for reporting to the reading device (52);
- a characteristic (watermark/hash, see 102 above) of the content of the information received by the application reporting unit (57) and a verifying unit (53) for receiving characteristics (from disk 51 and from decoder 57 thru 56 to 53), of the content of the information transmitted from the reading device to the application device (when received the signal is processed to locate the return a watermark), reported the application report unit and for verifying the characteristic by comparison (by 53, controlling switch 54).

Further regarding claims 10-11, Linnartz fails to particularly support the claim language as recited:

O wherein the application unit continuously reporting to the reading device a characteristic of the content received, but, merely seems to suggest a one shot,



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return of a watermark, hash and/or signature, possible in encrypted form (Fig.6)

Cox teaches watermarking video by (col. 2, lines 46-49 for example), providing watermarks every N<sup>th</sup> frame or to provide periodic watermarking thru-out the video, further content owners wish to protect each and every frame, as taught by Cox.

Therefore, it is known to provide periodic watermarking of material, even as suggested to watermark each frame, therefore, it would have been obvious to one skilled in the art to watermark periodically or even every frame, as taught by Cox which content owners would prefer, which would provide higher levels of protection to content owners.

Therefore, upon having periodic or every frame watermarked, upon a system that the decoder detects and reports back, the decoder in effect would be continuously sending watermarks removed continuously reported back to the verifying unit verifies the continuous characteristic received continuously, as is considered to be obvious to one skilled in the art.

#### ***Allowable Subject Matter***

2. Claims 1-6, 9, 11, {11 in view of claim 9} are allowed over the art of record.

#### **Contact Fax Information**

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


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Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
9/20/04

  
VINCENT BOCCIO  
PRIMARY EXAMINER